

**REMARKS**

Claims 1-62 are pending in the present application. By this Response, claims 1, 28, 34 and 61 are amended to recite the feature of advertisements being automatically presented based on a scheduled time and duration, wherein the advertisement is selected from a predetermined schedule of advertisements to be presented. In addition, claims 12, 33, 45 and 62 are amended to recite the feature of initial information about an item automatically being displayed based on a scheduled time and duration, wherein the initial information is selected from a predetermined schedule of information to be displayed. Additionally, claims 8 and 41 are canceled. Reconsideration of the claims is respectfully requested.

**I. 35 U.S.C. § 102, Alleged Anticipation of Claims 1-7, 9-16, 20, 21, 23-31, 33-40, 42-49, 53, 54 and 56-62**

The Office Action rejects claims 1-7, 9-16, 20, 21, 23-31, 33-40, 42-49, 53, 54 and 56-62 under 35 U.S.C. § 102(e) as being allegedly anticipated by Rautila et al., (U.S. Patent No. 6,549,625). This rejection is respectfully traversed.

With regard to claim 1, the Office Action states:

As per claim 1, Rautila teaches:

A method in a data processing system for presenting information, the method comprising:

presenting advertisements for at least one item on at least one display device in the data processing system (see column 2, line 13 - column 3, line 4; column 4, lines 15-32; column 7, lines 51-65; figure 3; column 10, lines 9-46); and

responsive to a request for information about at least one item from a mobile device, transmitting the information about at least one item to the mobile device (see column 4, lines 15-54; column 7, lines 1-10; column 7, lines 51-65; figure 3; column 9, lines 34-42; column 10, lines 9-46).

Office Action dated January 28, 2004, pages 2-3.

Claim 1, which is representative of claims 28, 34 and 61 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system for presenting information, the method comprising:  
determining whether an advertisement is to be presented;

presenting the advertisement on at least one display device for at least one item in the data processing system, wherein the advertisement is automatically presented based on a scheduled time and duration, and wherein the advertisement is selected from a predetermined schedule of advertisements to be presented; and

responsive to a request from a mobile device for the advertisement for at least one item, transmitting the advertisement for the at least one item to the mobile device. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Rautila does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, Rautila does not teach that an advertisement is automatically presented based on a scheduled time and duration. Similarly, Rautila does not teach that the advertisement is selected from a predetermined schedule of advertisements to be presented as recited in claims 1, 34 and 61.

Rautila is directed to a communications system for wirelessly broadcasting information from an information source to a mobile device. Position transceivers are connected to a network server to detect the presence of a mobile device, and broadcast information sent by the server upon detection. The mobile device consists of a first and a second transceiver. The first transceiver communicates with the position transceivers and the second transceiver communicates with a network. The mobile device receives the initial information from a connection with the first transceiver and enables the user to request additional information over a network with the second transceiver.

Thus, Rautila is concerned with detecting a mobile device and transmitting information to the device. While Rautila may teach a communications system for broadcasting information to a mobile device, there is nothing in Rautila that teaches that an advertisement is automatically presented based on a scheduled time and duration.

Similarly, Rautila does not teach that the advertisement is selected from a predetermined schedule of advertisements to be presented. To the contrary, Rautila teaches that the broadcast information is manually changed at column 2, lines 37-41, which reads as follows:

In another preferred embodiment of the invention, the information which is broadcasted is changed using a keyboard of the position transceiver or a PC connected to the position transmitter. The position transmitter only accepts appropriately authenticated changes.

Thus, the broadcast information is changed using a keyboard connected directly to the position transceiver or a keyboard connected to a PC, which is connected to the position transceiver. The broadcast information is manually changed by human intervention. Therefore, the selection of broadcast information is not automatically presented based on a scheduled time and duration. Thus, Rautila does not teach that an advertisement is automatically presented based on a scheduled time and duration or that the advertisement is selected from a predetermined schedule of advertisements to be presented.

With regard to Claim 12, the Office Action states:

As per claim 12, Rautila teaches:

A method in a data processing system for presenting an advertisement, the data processing system comprising:

displaying initial information about an item on a display device (see column 2, line 13 - column 3, line 4; column 4, lines 15-32; column 7, lines 51-65; figure 3; column 10, lines 9-46);

receiving a request from a mobile device for additional information about the item, wherein the request is received from a wireless communication link between the data processing system and the mobile device (see column 2, line 13 - column 3, line 4; column 4, lines 15-32; column 7, lines 51-65; figure 3; column 10, lines 9-46);

responsive to the request from the mobile device for the additional information about the item, sending the additional information to the mobile device (see column 2, line 13 - column 3, line 4; column 4, lines 15-32; column 7, lines 51-65; figure 3; column 10, lines 9-46.)

Office Action dated January 28, 2004, pages 4-5.

Claim 12, which is representative of claims 33, 45 and 62 with regard to similarly recited subject matter, reads as follows:

12. A method in a data processing system for presenting an advertisement, the data processing system comprising:
- displaying initial information about an item on a display device, wherein the initial information is automatically displayed based on a scheduled time and duration, and wherein the initial information is selected from a predetermined schedule of information to be displayed;
  - receiving a request from a mobile device for additional information about the item, wherein the request is received from a wireless communication link between the data processing system and the mobile device; and
  - responsive to the request from the mobile device for the additional information about the item, sending the additional information to the mobile device.

There is nothing in Rautila that teaches that an advertisement is automatically presented based on a scheduled time and duration or that the advertisement is selected from a predetermined schedule of advertisements to be presented, as set forth above with regard to claims 1, 34 and 61. For the same reasoning, Rautila does not teach that initial information is automatically presented based on a scheduled time and duration. Similarly, Rautila does not teach that the initial information is selected from a predetermined schedule of information to be presented. There is simply nothing in Rautila that teaches presenting any type of information based on a scheduled time and duration.

In view of the above, Applicants submit that Rautila does not teach each and every feature of independent claims 1, 12, 28, 33, 34, 45, 61 and 62 as required under 35 U.S.C. § 102(e). At least by virtue of their dependency on claims 1, 12, 28, 34 and 45, Rautila does not teach each and every feature of dependent claims 2-7, 9-11, 13-16, 20-21, 23-27, 29-31, 35-40, 42-44, 46-49, 53-54 and 56-60. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-16, 20-21, 23-31, 34-40, 42-49, 53-54 and 56-62 under 35 U.S.C. § 102(e).

Furthermore, Rautila does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Rautila actually teaches away from the presently claimed invention because it teaches manually changing the displayed information as opposed to automatically presenting the information based on a scheduled time and duration as in the presently claimed invention. Absent the Examiner pointing

out some teaching or incentive to implement Rautila to change the displayed information automatically and according to a scheduled time and duration, one of ordinary skill in the art would not be led to modify Rautila to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Rautila in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

## **II. 35 U.S.C. § 103, Alleged Obviousness of Claims 17, 18, 50 and 51**

The Office Action rejects claims 17, 18, 50 and 51 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rautila et al., (U.S. Patent No. 6,549,625) in view of Owensby (U.S. Patent No. 6,647,257). This rejection is respectfully traversed for at least the same reasons as set forth above with regard to independent claims 12 and 45 from which claims 17, 18, 50 and 51 depend.

Specifically, Rautila does not teach that initial information is automatically presented based on a scheduled time and duration, wherein the initial information is selected from a predetermined schedule of information to be presented. In addition, Owensby does not provide for the deficiencies of Rautila. That is, neither Rautila nor Owensby, either alone or in combination, teach or suggest that initial information is automatically presented based on a scheduled time and duration, wherein the initial information is selected from a predetermined schedule of information to be presented.

Owensby is directed to a system for broadcasting advertisements to subscribers for the purpose of reducing the cost to the subscriber. Advertisements are targeted to the user based on Wireless Mobile Location Data, Subscriber Profile Data, Historical Response Data relating to the responses made to the targeted messages previously or Historical Response Data relating to the historical movement patterns of the subscriber. While Owensby may teach sending targeted advertisements to a user of a mobile device, there is absolutely nothing in Owensby that teaches that the advertisements are displayed according to a scheduled time and duration. Rather, Owensby teaches that the messages

are targeted to the subscriber based on real-time, physical location of the mobile terminal.  
(column 3, lines 5-7, Owensby)

**III. 35 U.S.C. § 103, Alleged Obviousness of Claims 19, 22, 52 and 55**

The Office Action rejects claims 19, 22, 52 and 55 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rautila et al., (U.S. Patent No. 6,549,625) in view of Burke et al. (U.S. Patent No. 4,468,813). This rejection is respectfully traversed for at least the same reasons as set forth above with regard to independent claims 12 and 45 from which claims 19, 22, 52 and 55 depend.

Specifically, Rautila does not teach that initial information is automatically presented based on a scheduled time and duration, wherein the initial information is selected from a predetermined schedule of information to be presented. In addition, Burke does not provide for the deficiencies of Rautila. That is, neither Rautila nor Burke, either alone or in combination, teach or suggest that initial information is automatically presented based on a scheduled time and duration, wherein the initial information is selected from a predetermined schedule of information to be presented.

Burke is directed to a system for electronically storing up to forty-two seconds of voice recordings on a mobile radio communications system comprising up to eight different messages. The system permits base interrogation of mobiles to determine the remaining recording capacity and total recording capacity of the mobile radio communications system. There is nothing in Burke that has anything to do with presenting information based on a scheduled time and duration. Recordings are not left based on a scheduled time or duration. Rather, a recording is left when the mobile radio communications system is contacted, regardless of any schedule. In addition, the voice recordings are not selected from a predetermined schedule of information.

Furthermore, claims 19 and 52 are patentable over Rautila and Burke by virtue of the specific features recited therein. That is, neither Rautila nor Burke, either alone or in combination, teach or suggest that the additional information includes a selected amount of detail about the item based on a mobile device type. The Office Action admits that

this feature is not taught in Rautila. The Office Action, however, alleges that this feature is taught in Burke. Applicants respectfully disagree.

The Office Action states that "Burke teaches about a system that permits base interrogation of mobile units to determine if a message has been stored for review by the base operator and to determine recording capacity of the mobile unit." (Office Action, page 12) While Burke may teach interrogating mobile units to determine if a message has been stored and to determine recording capacity, this information is not based on the type of mobile device. Rather, this information is based on whether a message has been left on the mobile device and, if so, the duration of the message. Thus, neither Rautila nor Burke, either alone or in combination, teach or suggest that the additional information includes a selected amount of detail about the item based on a mobile device type.

Furthermore, one of ordinary skill in the art Rautila and Burke would not be motivated to combine the references in the manner alleged in the Office Action. There is simply no teaching or suggestion in either Rautila or Burke regarding any problem for which the other reference is a solution. There is nothing in Rautila that has anything to do with a solid-state voice storage system. Similarly, Slemmer does not have anything to do with broadcasting advertisements to a mobile device over a wireless channel. Thus, the alleged combination can only be the result of impermissible hindsight reconstruction using Applicants' own disclosure as a guide. While Applicants understand that all examination entails some measure of hindsight, when the rejection is based completely on hindsight, as in the present case, to the exclusion of what can be gleaned from the references, then the rejection is improper and should be withdrawn.

#### **IV. 35 U.S.C. § 103, Alleged Obviousness of Claim 32**

The Office Action rejects claim 32 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rautila et al., (U.S. Patent No. 6,549,625) in view of Slemmer et al. (U.S. Patent No. 6,377,990). This rejection is respectfully traversed for at least the same reasons as set forth above with regard to independent claim 28 from which claim 32 depends.

Specifically, Rautila does not teach that an advertisement is automatically presented based on a scheduled time and duration. Similarly, Rautila does not teach that the advertisement is selected from a predetermined schedule of advertisements to be presented. In addition, Slemmer does not provide for the deficiencies of Rautila. That is, neither Rautila nor Slemmer, either alone or in combination, teach or suggest that an advertisement is automatically presented based on a scheduled time and duration or that the advertisement is selected from a predetermined schedule of advertisements to be presented.

Slemmer is directed to a system for accessing a network with a computer that is not specifically configured for that particular network. The computer determines the network adapter address associated with a target IP address by broadcasting an address resolution protocol (ARP) message. The ARP includes the target IP address and the network adapter address and IP address of the computer broadcasting the ARP. A computer having the target IP address responds to an ARP by sending a response message that includes the network adapter address if the computer having the target IP address.

The only thing that Slemmer has in common with the present invention is that the system involves a computer. Slemmer is concerned with allowing a user to connect to a network other than the network that the computer is configured to access. The present invention is directed to a system for broadcasting advertisements wirelessly to a mobile device. There is simply no teaching or suggestion in either Rautila or Slemmer regarding any problem for which the other reference is a solution. There is nothing in Rautila that has anything to do with broadcasting a message over a network to determine a target IP address. Similarly, Slemmer does not have anything to do with broadcasting advertisements to a mobile device over a wireless channel. Thus, the alleged combination can only be the result of impermissible hindsight reconstruction using Applicants' own disclosure as a guide. While Applicants understand that all examination entails some measure of hindsight, when the rejection is based completely on hindsight, as in the present case, to the exclusion of what can be gleaned from the references, then the rejection is improper and should be withdrawn.



**V. 35 U.S.C. § 103, Alleged Obviousness of Claims 8 and 41**

The Office Action rejects claims 8 and 41 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rautila et al., (U.S. Patent No. 6,549,625) in view of DeLuca et al. (U.S. Patent No. 6,313,732). This rejection is respectfully traversed. By this Response, claims 8 and 41 are canceled. The features of claims 8 and 41 are incorporated into claims 1, 28, 34 and 61.

Rautila does not teach that an advertisement is automatically presented based on a scheduled time and duration or that the advertisement is selected from a predetermined schedule of advertisements to be presented as set forth above. In addition, DeLuca does not provide for the deficiencies of Rautila. That is, neither Rautila nor DeLuca, either alone or in combination, teach or suggest that an advertisement is automatically presented based on a scheduled time and duration or that the advertisement is selected from a predetermined schedule of advertisements to be presented.

DeLuca is directed to a system for displaying advertisement information on a pager. The user may receive personal messages and other information updates for no fee by reading a proportional number of advertisements. Responding to questions within advertisements can increase the number of messages that can be received. In addition, the advertisement must remain on the pager screen for a predefined period of time in order for the user to get credit for viewing the advertisement. This is to prevent the user from merely scrolling past the advertisement.

There is nothing in DeLuca that teaches that advertisements are automatically presented based on a scheduled time and duration. At best, DeLuca teaches that advertisements must remain on the display of a pager for predetermined duration. The advertisement, however, is not displayed in accordance to any schedule. To the contrary, at column 8, lines 29-32, DeLuca teaches that the advertisement can be viewed at a time convenient to the user. Thus, the advertisements in DeLuca are not displayed in accordance with a schedule. Rather, the advertisements are displayed when the user decides to view the advertisement. In addition, there is nothing in DeLuca that teaches that the advertisements are sent to the pager based on a scheduled time and duration. In

DeLuca, the predetermined amount of time is only a minimum amount for which the advertisement must be viewed and has nothing to do with a scheduled time and duration.

**VI. Conclusion**

It is respectfully urged that the subject application is patentable over Rautila, Owensby, Burke, Slemmer and DeLuca and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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